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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------------|---------------------|------------------|
| 10/823,457 | 04/12/2004 | Gordon R. Knight | 08173-009005 | 5666 |
| 20/985 7590 01/08/2009 FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | | |
| EXAMINER CHU, KIM KWOK | | | | |
| ART UNIT 2627 | | PAPER NUMBER | | |
| NOTIFICATION DATE 01/08/2009 | | DELIVERY MODE ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary

Application No.

10/823,457

Applicant(s)

KNIGHT ET AL.

Examiner

Kim-Kwok CHU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 10/1/2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/846,916.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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Continued Examination after Final Rejection

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/2008 has been entered.

Drawings Objected To, Details Not Shown

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, according to Claim 1, the claimed features "disk drive to receive said carrier (including an electronic element) and said cartridge", "a detection unit within said disk drive" and "a transfer unit within said disk drive" must be shown or the feature canceled from the claims. No new matter should be entered.

Similarly, according to Claim 2, the claimed feature "an electronic element in said cartridge having updatable information" must be shown or the feature canceled from the claims. No new matter should be entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless--
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 1 and 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Monahan et al. (U.S. Patent 5,388,260).

Monahna teaches a data storage system of a disk having all of the elements and means as recited in claims 1 and 12-14. For example, Monahan teaches the following:

Regarding to Claim 1, the data storage system comprising a cartridge 4 (Fig. 3) to enclose a disk capable of storing data and to have a cartridge door (parts of a disc drive 4) to permit access to a disk surface of the disk (Fig. 3; disc drive has an opening/door for inserting a disc); a carrier structured 2 (Figs. 1 and 3; housing) to enclose the cartridge 4 and have a carrier door 9 (Fig. 2; column 6, lines 26 and 27) to permit access to the cartridge 4 (Figs. 1 and 2), the carrier 2 (housing) including an electronic element 17 (Fig. 3; system controller) to have updatable information about contents of data

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in the disk enclosed in the cartridge 1 (column 6, lines 41-45), a display 11 (Fig. 1; console) operable to display the updatable information (Fig. 1; column 6, lines 33-35), and a user control 12 (keyboard) to control which portion of the information is displayed (Fig. 1); a locking element operable to lock the cartridge 4 within the carrier 1 (Fig. 3; disc drive 4 is locked in the carrier); a disk drive 1 (Fig. 5) to receive (including) the carrier 2 and the cartridge 4 (Figs. 1 and 5); a detection unit (in controller 17) within the disk drive 1 to detect that a carrier has been received at least partially within said disk drive (Figs. 5 and 6); and a transfer unit (Fig. 4) within the disk drive 1 to transfer a cartridge 4 from within the carrier 2 to an interior of the disk drive 4 (Figs. 3 and 4).

Regarding Claim 12, the disk is a first surface recording disk (Fig. 8).

Regarding Claim 13, the disk is a magneto-optical disk (column 2, lines 28-30; storage medium in an automated library).

Regarding Claim 14, the disk is an optical near-field recording disk (column 2, lines 28-30; storage medium in an automated library).

6. Claims 2-7, 9, 11, 15, 18 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Bloch et al. (U.S. Patent 5,745,102).

Bloch teaches a cartridge system having all of the elements and means as recited in claims 2-7, 9 and 15. For example, Bloch teaches the following:

Regarding to Claim 2, the cartridge system for a recording medium (Fig. 1A), comprising: a recording medium 120 (floppy disk); a cartridge 118 (Fig. 1A) enclosing the recording medium 120, the cartridge 118 having a cartridge door (Fig. 1A; sliding opening) to permit access to the recording medium 120; an electronic element 114 in the cartridge 118 having updatable information indicative of contents of data in the recording medium 120 enclosed in said cartridge 118 (Fig. 4A; column 3, lines 24-39); a display 410 (Fig. 4A) located in the cartridge 118 operable to display the data; and a user control 414 for controlling which portion of said information is displayed (Fig. 4B).

Regarding Claim 3, the electronic element 414 stores at least one of a file directory, a file size, or a date (Fig. 4B; column 3, lines 24-39).

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Regarding Claim 4, a power supply 116 for the electronic element (Fig. 4A).

Regarding Claim 5, the power supply is a battery 116 (Fig. 4A).

Regarding Claim 6, the user control includes at least one button/input (Figs. 4B and 7B; file directory are inputted by keys).

Regarding Claim 7, the recording medium 120 is a disk (Fig. 1A).

Regarding to Claim 9, the recording medium is a hard drive (column 1, storage medium can be considered as a hard drive).

Regarding to Claim 15, the recording medium is a first surface recording disk (Fig. 1A; storage medium has a disk access opening to read/write a first disk surface).

7. Claims 11, 18 and 21, have limitations similar to those treated in the above rejection, and are met by the reference as discussed above. Claims 18 and 19 however also recite the following limitations which are also taught in the prior art of Bloch:

Regarding to Claim 18, the disk is a first surface recording disk (floppy disk).

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Regarding to Claim 21, the electronic display is a liquid crystal display (Figs. 4A and 8B).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 10 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Bloch et al. (U.S. Patent 5,745,102) in view of Ichikawa et al. (U.S. Patent 5,418,763).

Bloch teaches a cartridge very similar to that of the present invention. However, Bloch does not teach that a carrier enclosing the cartridge and the carrier including a display operable to display data.

Ichikawa teaches an optical carrier enclosing cartridges and the carrier including a display 18 operable to display data. (Fig. 1; column 7, last 3 lines).

When accessing Bloch's cartridge located in a carrier such as a disk library, the contents of the disk inside the cartridge should be displayed. For example, it would have been obvious to

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one of ordinary skill in the art to adapted a display means such as Ichikawa's library control unit in his cartridge carrier so that disk management information such as the track addresses of the storage medium can be displayed to a library operator.

10. Claim 8 is rejected under 35 U.S.C. 103 (a) as being unpatentable over Bloch et al. (U.S. Patent 5,745,102) in view of Burke et al. (U.S. Patent 5,613,154).

Bloch teaches a cartridge very similar to that of the present invention. However, Bloch does not teach that the optical disk inside the cartridge is a tape.

Burke teaches a cartridge containing a tape as a recording medium(Fig. 4; column 5, lines 35-51).

For displaying files stored in a recording medium, it would have been obvious to one of ordinary skill in the art to house Burke's tape storage medium in a cartridge similar to Bloch's, because the cartridge not only prevents the disk recording surface being damaged by dusts and scratches and in addition shows the contains in the disk without using a disk drive.

11. Claims 17 and 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bloch et al. (U.S. Patent 5,745,102) in view of Guerra (U.S. Patent 6,094,413).

Bloch teaches a cartridge very similar to that of the present invention. However, Bloch does not teach that the optical disk inside the cartridge is an optical near-field recording disk.

Guerra teaches an optical near-field recording disk which is enclosed by a cartridge 191 (Fig. 31; column 17, lines 33-67).

For displaying files stored in a recording medium, it would have been obvious to one of ordinary skill in the art to house Guerra's near-field optical storage medium in a cartridge similar to Bloch's, because the cartridge not only prevents the disk recording surface being damaged by dusts and scratches and in addition shows the contents in the disk without using a disk drive.

12. Claims 16 and 19 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Bloch et al. (U.S. Patent 5,745,102) in view of Suzuki et al. (U.S. Patent 5,640,535).

Bloch teaches a cartridge very similar to that of the present invention. However, Bloch does not teach that the optical disk inside the cartridge is a magneto-optic disk.

Suzuki teaches a magneto-optical disk inside a cartridge 11a (Fig. 4; column 1, lines 12-17).

For displaying files stored in a recording medium, it would have been obvious to one of ordinary skill in the art to house Suzuki's magneto-optical storage medium in a cartridge similar to Bloch's, because the cartridge not only prevents the disk recording surface being damaged by dusts and scratches and in addition shows the contents in the disk without using a disk drive.

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13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/

Examiner AU2627

January 4, 2009

(571) 272-7585

/HOA T NGUYEN/

Supervisory Patent Examiner, Art Unit 2627